

1 ANNE M. CAPPELLA (Bar No. 181402)
 (anne.cappella@weil.com)
 2 WEIL, GOTSHAL & MANGES LLP
 201 Redwood Shores Parkway
 3 Redwood Shores, CA 94065
 Telephone: (650) 802-3141
 4 Facsimile: (650) 802-3100

5 Attorney for Movant
 APPLE INC.

Filed

JAN 28 2013

RICHARD W. WIEKING
 CLERK, U.S. DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN JOSE

7 **IN THE UNITED STATES DISTRICT COURT**

8 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**

9 **SAN JOSE DIVISION**

10 APPLE INC.,

11 Movant,

12 v.

13 GOOGLE INC.,

14 Respondent.

CV 13 80019 MISC.

**NOTICE OF MOTION, MOTION TO
 COMPEL COMPLIANCE WITH A
 SUBPOENA**

PSG

[Consolidated Civil Action Case Nos. 1:12-cv-
 23580-RNS and 1:12-cv-20271-RNS
 U.S.D.C. S.D. FL.]

Hearing: To Be Set
 Time: To Be Set

17 NOTICE is hereby given of the filing of this motion pursuant to Rules 37(a) and
 18 45(c)(2)(B)(i) of the Federal Rules of Civil Procedure and Civil Local Rule 7 by Anne M.
 19 Cappella, on behalf of Apple, Inc. ("Apple"). This motion seeks to compel Google Inc.
 20 ("Google") to comply with the August 27, 2012 subpoena issued to it from this Court ("the
 21 Subpoena"). Pursuant to Civil Local Rule 37-1(a), the undersigned represents that counsel for
 22 Apple has previously attempted to confer with counsel for Google for the purpose of attempting
 23 to resolve the issues addressed in this motion, but that, after conferring, Google has failed to
 24 fully comply with the Subpoena. In support of its motion, Apple is also filing the Declaration of
 25 Robert T. Vlasits, with exhibits attached. The date and time of the hearing on this motion have
 26 yet to be set.

27 This motion respectfully requests an order from this Court compelling Google to fully

1 comply with the Subpoena. The anticipated discovery would assist Apple in the preparation of
2 its case in *Motorola Mobility, LLC v. Apple Inc.*, Consolidated Case Nos. 1:12-cv-23580-RNS
3 and 1:12-cv-20271-RNS (S.D. Fla.). In that suit, Motorola Mobility, LLC (“Motorola”)—a
4 wholly-owned subsidiary of Google—has accused Apple of infringing several of its patents, and
5 Apple has counterclaimed, asserting several of its own patents against Motorola. Apple alleges
6 that seven of its patents are infringed by Motorola’s mobile phones and tablets that perform
7 specific functionalities or features enabled, executed, or supported by Google’s Android mobile
8 operating system and related proprietary software applications. *See* Vlasis Decl. at ¶ 12, Exh. J.
9 Such features concern, for example, Google Maps, the Android Market and Google Play stores,
10 notifications, text input autocorrection, and unlocking the phone by performing a sliding gesture
11 on the touchscreen. *See id.* Additionally, Apple alleges that three of its patents are infringed by
12 Motorola’s set-top box products. *See id.* In a recent turn of events, Google announced the sale
13 of Motorola’s set-top box division to Arris Group, Inc. on December 19, 2012. *See, e.g.*, Press
14 Release, ARRIS to Acquire Motorola Home Business for \$2.35 Billion In Cash And Stock (Dec.
15 19, 2012) (attached hereto as Exh. 1). Apple’s Subpoena to Google concerns these issues and
16 Google’s noncompliance impairs Apple’s ability to develop its infringement and damages case
17 against Motorola.

18 I. INTRODUCTION

19 This is not your typical motion to compel compliance with a subpoena and Google is not
20 your typical third party. Google is the parent company of Motorola, the defendant and
21 counterclaimant in the litigation underlying this motion. Further, Google’s Android operating
22 system forms the crux of Apple’s infringement case against many of Motorola’s accused
23 products. In fact, even before Google’s acquisition of Motorola was final, Google demanded the
24 right to control Motorola’s litigations against Apple. *See, e.g.*, Agreement of Plan of Merger By
25 and Among Google Inc., Inc. and Motorola Mobility Holdings, Inc. at § 5.01(v) (Form 8-K, Ex-
26 2.1) (Aug. 15, 2011). Indeed, Google and Motorola are even represented by the same law firm in
27 Motorola’s various litigations against Apple across the country. Similarly, Google has
28

1 announced that it is selling Motorola's set top box business to ARRIS and granting ARRIS a
2 license to its patent portfolio. *See* Press Release, ARRIS to Acquire Motorola Home Business for
3 \$2.35 Billion In Cash And Stock (Dec. 19, 2012) (attached hereto as Exh. 1). Many of Apple's
4 patents at issue are directed to that portion of Motorola's business and the acquisition clearly
5 includes relevant information to the valuation of Motorola's patent portfolio that it licensed as
6 part of the deal.

7 Despite Google's central role in the Motorola business at issue in these litigations and the
8 undeniable relevance of the information it possesses, Google has repeatedly attempted to resist
9 discovery and still has not provided numerous categories of requested information in the current
10 litigation in Florida. Time and again, Google has forced Apple to seek the Court's assistance
11 rather than turn over the requested discovery and its prior attempts to thwart discovery have not
12 been well received. *See Apple Inc. et al. v. Motorola, Inc. et al.*, No. 1:11-cv-08540 at 1 (N.D.
13 Ill. Feb. 21, 2012) ("Motorola shall be expected to obtain full and immediate compliance by
14 Google with Apple's liability discovery demands.") (attached hereto as Exh. 2); *Apple Inc. et al.*
15 *v. Motorola, Inc. et al.*, No. 1:11-cv-08540 at 1 (N.D. Ill. Mar. 5, 2012)] (granting Apple's
16 motion to compel Google discovery) (attached hereto as Exh. 3).

17 Undeterred, Google is yet again attempting to block discovery into crucial aspects of this
18 case. Over four months have passed since Apple's Subpoena, but to date Google has only
19 produced a limited subset of documents partially responsive to some documents requests and has
20 completely failed to provide any documents responsive to the majority of document requests.
21 Google has failed to do so despite (i) Apple's multiple requests to Google that it comply with the
22 Subpoena, (ii) Apple's efforts to assist Google in complying with the Subpoena by providing
23 Google with detailed information regarding the claims at issue; (iii) Google's own agreement to
24 comply with the Subpoena by November 1 or shortly thereafter; and (iv) Google's subsequent
25 agreement to comply with the Subpoena promptly upon entry of an amended protective order,
26 which was entered on November 28, 2012.

27 Apple can wait no longer for this crucial discovery. Google's undue delay, broken
28

promises, and failure to assure timely and fully responsive document productions have and continue to prejudice Apple. Accordingly, Apple respectfully requests that this Court order Google to promptly produce documents and designate witnesses in response to Apple's Subpoena.

II. STATEMENT OF RELEVANT FACTS

On August 27, 2012, Apple served Google with a duly issued Subpoena. *See* Vlasis Decl. at ¶ 2; Exh. A. Apple's Subpoena set forth various document requests and topics for deposition testimony concerning the accused features of the Android operating system, such as:

11. Any design specifications supplied by Google to Motorola for any hardware or Software aspects of any Motorola Accused Mobile Devices or any Motorola Accused Set-Top Box Devices.

16. Documents and Things sufficient to fully describe the development, use, and implementation of all process(es) and/or functionality(ies) in the Android Platform for locking and unlocking the touchscreen, including but not limited to gesture-to-unlock functionalities.

36. Any studies, analyses, investigations, or inquiries regarding customer demand for or value ascribed to any Android device unlock feature, any Android text autocorrect feature, the Android Toast class, or the Google Maps, Places, Play Store, or Android Market applications.

43. All Documents or Things comprising, or referring or relating to, comparisons between any feature of Android, or of any Motorola Accused Mobile Device, or any Android-based products, to any iPhone, iPad, iPod Touch, or to the iOS operating system, including comparisons relating to the unlocking or text autocorrect or autocomplete features of such devices, the Android Toast class, or the Google Play Store, or Android Market applications.

47. All documents relating to the revenue generated from or profits or losses associated with the Google Map, Places, and Plus applications, including any documents relating to business strategies, projections, analyses or forecasts relating to revenue or profitability associated with such applications as well as any documents specifically relating to the portions of any revenues, profits, or losses associated with the use of these applications on any Motorola Accused Mobile Device.

53. Documents and Things sufficient to show the amount of investment that Google has made for the development, use, and implementation of the Android unlock feature, any Android text autocorrect or autocomplete feature, the Android Toast class, or the Google Maps, Places, Plus, Play Store, or Android Market applications.

57. All communications with third parties, including but not limited to Motorola (or anyone acting on behalf of Motorola), relating to the purchase, acquisition, negotiation for, and/or value of Motorola Mobility Holdings or any portion or assets thereof.

63. All communications and documents relating to Google's post-merger plans and strategies for the business, assets, and intellectual property of Motorola and/or Motorola Mobility Holdings.

Google served its objections and responses thereto on September 12, 2012, indicating that it would not designate any witness for the vast majority of deposition topics nor provide documents responsive to nearly all of the documents requests. *See* Vlasis Decl. at ¶¶ 3, 4; Exhs. B, C. Apple and Google then met-and-conferred on September 18, and Apple agreed to provide Google with a description of the asserted patents and accused functionalities to aid in Google's production. *See* Vlasis Decl. at ¶¶ 5-6; Exh. D. On September 28, Apple tendered a detailed lettered to Google with descriptions of the accused functionalities and a list of focused document requests to assist Google in complying with the Subpoena. Apple also requested that Google identify a date certain by which it would begin its production and designate witnesses. *See* Vlasis Decl. at ¶ 7; Exh. E. Having heard no response, on October 8, Apple again prompted Google to identify a date certain by which it would begin productions and identify witnesses. *See* Vlasis Decl. at ¶ 8; Exh. F. Google finally responded on October 12, indicating that it would comply with the Subpoena and even stating that it had already begun its document collection and review. *See* Vlasis Decl. at ¶ 9; Exh. G. Google did not, however, provide a date by which its productions would begin but instead concluded that because "[f]act discovery in this action doesn't close until July 5, 2013 ... there is no time pressure." *Id.* Apple responded on October 18, explaining the need for Google's prompt compliance with the Subpoena, in particular because Google's delayed discovery was prejudicing Apple's ability to use relevant information in its infringement contentions due November 7. *See* Vlasis Decl. at ¶ 10; Exh. H. Accordingly, Apple requested that Google commence productions no later than November 1, 2012. *Id.*

On October 25, Google responded by stating that it likely would not produce any documents by November 1, but that in any event, Google should be able to commence its production "shortly thereafter." *See* Vlasis Decl. at ¶ 11; Exh. I. Two and half weeks after this promise, the deadline for exchanging infringement contentions with Motorola had passed, and Google still had not provided any discovery. As a result, Apple was unable to identify any

1 source code or provide much detail about the Android operating system and related applications
2 in its infringement contentions. *See* Vlasis Decl. at ¶ 12; Exh. J. In other words, Apple had to
3 rely primarily on publicly available information about the accused features and functionalities in
4 support of its infringement theories. Apple thus notified Google that it intended to seek judicial
5 relief if substantial document productions were not made by November 30. *See* Vlasis Decl. at ¶
6 13; Exh. K.

7 On November 19, Google for the first time indicated to Apple that it could not begin
8 document productions until the protective order in the underlying litigation with Motorola was
9 amended according to Google's proposed changes. *See* Vlasis Decl. at ¶ 14; Exh. L; *see also*
10 Vlasis Decl. at ¶¶ 16, 17; Exhs. N-1, O (November 27th letter from Google's counsel stating that
11 "Google will commence its production ... promptly upon the Court's entry of our agreed
12 order."). Although Apple did not agree with the full scope of Google's proposed changes, Apple
13 did not oppose amending the protective order so as not to further delay Google's productions.
14 *See* Vlasis Decl. at ¶ 15; Exh. M. Accordingly, the motion to amend the protective order was
15 filed on November 26 and granted by the Court the following day. *See* Vlasis Decl. at ¶¶ 16, 18;
16 Exhs. N, N-1, P. Immediately thereafter, Apple provided Google with notice of the Court's
17 order to ensure that Google's production would go forward by November 30. *See* Vlasis Decl. at
18 ¶ 19; Exh. Q.

19 Though Google did make available certain source code from its Android software on
20 November 29, Google did not produce a single document or designate any witnesses for
21 deposition. *See* Vlasis Decl. at ¶ 20; Exh. R. Apple therefore requested that Google comply
22 with its discovery obligations yet again by making document productions no later than 5:00 PM
23 on December 7. *See id.*

24 Finally, on December 7, Google produced some of the requested documents. *See* Vlasis
25 Dec. at ¶ 22; Exh. S. Unfortunately, this production fell far short of meeting Google's discovery
26 obligations. Google's meager production consisted almost entirely of emails among Google
27 employees and only a handful of non-email documents, many of which were identical.
28

Moreover, this limited production was not at all responsive to the majority of document request categories listed in the Subpoena.

III. ARGUMENT

Rule 26(b)(1) permits discovery in civil actions of “any matter, not privileged, that is relevant to the claim or defense of any party....” FED. R. CIV. P. 26(b)(1). The information requested by the Subpoena is unquestionably relevant to Apple’s infringement allegations. Apple has accused Motorola of making, using and selling forty-three different mobile device products that are all designed around and enabled by the Android operating system and associated application software. Google designs and develops this Android software, which performs, supports or enables all of features that Apple has specifically accused of infringement. *See* Vlasis Decl. at ¶ 12, Exh. J. For instance, these features include the ability to slide one’s finger across the screen to unlock the phone, the display of notifications on the screen, a user interface for managing phone calls, the ability to purchase applications via an application management interface, text input autocorrection, and the provision of geographic location-based search results, among other accused features. Given the materiality of this information, such features are explicitly referenced in the Subpoena’s discovery requests. *See* Vlasis Decl. at ¶ 2; Exh. A.

Additionally, Google’s purchase of Motorola Mobility, LLC and its eventual sell-off of the set-top box division are clearly relevant to Apple’s damages case. Any negotiations, analyses, agreements, or spreadsheets concerning the value of the set-top box division or the value of Motorola’s smart phone and tablet business, for instance, would be relevant to show the value, popularity, profitability and commercial success of the accused products as well as information relating to any convoyed sales. *See, e.g., Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F.Supp. 1116 (S.D.N.Y. 1970). Google’s purchase of Motorola Mobility and its subsequent agreement to sell the set-top box division also included the transfer and license of patents. *See* Google Inc., Quarterly Report at 20 (Form 10-Q) (Jul. 24, 2012) (“Of the \$12.4 billion total purchase price ... \$5.5 billion was attributed to patents and developed

1 technology") (attached hereto as Exh. 4); Press Release, ARRIS to Acquire Motorola Home
2 Business for \$2.35 Billion In Cash And Stock (Dec. 19, 2012) ("The transaction will ... provide
3 [to ARRIS] a license to a wide array of Motorola Mobility patents.") (attached hereto as Exh. 1).
4 The negotiations and valuations concerning these patents are highly relevant to a comparative
5 royalty analysis, particularly with regard to the set-top box patents licensed to ARRIS. *See*
6 *Georgia-Pacific Corp.*, 318 F.Supp. at 1120.

7 Regardless of these points, the scope and relevance of the requested discovery is
8 undisputed and therefore not an issue. The parties have met-and-conferred and resolved
9 Google's objections to Apple's Subpoena, as indicated by Google's agreement to comply with its
10 discovery obligations. *See* Vlasis Decl. at ¶¶ 2-9; Exhs. A-G. Nonetheless, Google continues to
11 unreasonably delay its production of documents and witnesses, in spite having repeatedly (albeit
12 falsely) assuring Apple that it would meet deadlines which have come and gone. *See* Vlasis
13 Decl. at ¶¶ 11, 13,, 16-19; Exhs. I, K, N-Q.

14 These delays have already prejudiced Apple. For example, Apple relied on Google's
15 affirmation that it would either produce responsive documents on November 1 or "shortly
16 thereafter" so that Apple could use such relevant information in its infringement contentions due
17 November 7. *See* Vlasis Decl. at ¶¶ 10-11; Exhs. H, I. But, Google did not produce any
18 documents within that timeframe. Google instead waited nearly three weeks to inform Apple
19 that an amendment to the protective order was required before any productions could begin. *See*
20 Vlasis Decl. at ¶ 14; Exh. L. Although Google has since made certain Android source code and
21 a limited document production available, these productions did not arrive in time for the
22 infringement contentions deadline and did not include the vast majority of discovery that Apple
23 requested. *See* Vlasis Decl. at ¶ 20, 22; Exhs. R, S.

24 Moreover, Google's delays will continue to prejudice Apple as this case moves forward.
25 In one regard, Google's continued noncompliance limits Apple's ability to sufficiently conduct
26 necessary discovery from Google. For instance, Apple will have to review Google's production
27 and determine whether the produced documents fully comply with the scope of the requested
28

1 information or whether further discovery requests are needed. This process could be particularly
2 prolonged if Apple and Google need to settle any disputes concerning the extent of information
3 that must be produced. Additionally, Apple will need time to meaningfully review the
4 documents produced by Google before it can begin taking depositions of Google's Rule 30(b)(6)
5 witnesses. In another regard, Google's delays prejudice Apple's discovery efforts with
6 Motorola. Much of the information sought by the Subpoena will likely require further discovery
7 from Motorola, either through pertinent document requests or depositions of Motorola employees.

8 The prospect of ongoing prejudice is exacerbated by the fact that Google's delays are
9 unjustified and unexplained. Google has been on notice for over four months to provide the
10 requested discovery and yet it has not provided any documents at all responsive to thirty-five of
11 the sixty-three document requests included in the Subpoena. As discussed above, these requests
12 concern highly relevant issues material to Apple's damages and infringement case. Further, this
13 prejudice remains despite Google's sole December 7 document production, which cannot
14 reasonably be seen as Google meeting its discovery obligations. Of those documents that have
15 been produced, the range of relevant information conveyed, while being somewhat responsive to
16 a portion of the document requests, is extremely narrow in scope. To illustrate, Google's
17 December 7 production consisted almost entirely of emails of Google employees concerning
18 "bugs" and other technical issues related to (but do not sufficiently describe) relevant features of
19 the Android operating system. While partially responsive to Document Requests 16 through 41,
20 these emails are not stand-alone documents, slides, or spreadsheets that include product/feature
21 proposals, plans and evaluations, meeting minutes and slides, market/consumer studies, testing
22 or other similar responsive subject matter. Rather, the produced emails, many of which are the
23 same email or email chain¹, represent only a small subset of the universe of relevant documents
24 responsive to the Subpoena. Although Google's December 7 production does include a handful
25 of non-email documents, such documents are few and address only a portion of the scope of
26

27
28 ¹ In one instance, at least forty-five versions of the same email chain were produced, making up
almost a sixth of all the emails in the December 7 production.

1 Document Requests 16 through 41.²

2 Apple can no longer accommodate Google's unreasonable delays and failures to produce
3 requested discovery. After four months, Google should have already produced meaningful
4 documents responsive to all of the document requests in the Subpoena. Regardless of Google's
5 motive for delaying production, it should not be permitted to further prolong its deficient
6 participation in the discovery process at Apple's expense. *See Apple Inc. v. Samsung Elecs. Co.*,
7 2012 U.S. Dist. LEXIS 62947 (N.D. Cal. May 4, 2012) (granting-in-part motion to compel
8 Google's compliance with subpoena).

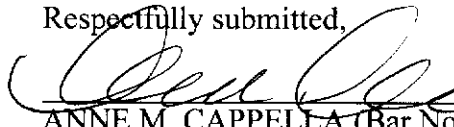
9 **IV. CONCLUSION**

10 Because Google's failure to comply with its discovery obligations has prejudiced and
11 continues to prejudice Apple's ability to develop its case, and because Apple can no longer rely
12 on Google's assurances to produce documents and provide witnesses by the requested deadlines,
13 Apple respectfully requests that this Court grant Apple's motion to compel Google's compliance
14 with the Subpoena.

15
16
17
18
19
20
21
22
23
24
25
26
27
28 ² As with the produced emails, many of the non-email documents are identical.

1 Dated: January 28, 2013

Respectfully submitted,

2 
3 ANNE M. CAPPELLA (Bar No. 181402)
4 (anne.cappella@weil.com)
5 WEIL, GOTSHAL & MANGES LLP
6 201 Redwood Shores Parkway
7 Redwood Shores, CA 94065
8 Telephone: (650) 802-3141
9 Facsimile: (650) 802-3100
10 *Of Counsel:*

11 Mark G. Davis
12 (mark.davis@weil.com)
13 WEIL, GOTSHAL & MANGES LLP
14 1300 Eye Street, N.W., Suite 900
15 Washington, DC 20005
16 Telephone: (202) 682-7000
17 Facsimile: (202) 857-0940

18 Kenneth H. Bridges
19 (kbridges@bridgesmav.com)
20 Michael T. Pieja
21 (mpieja@bridgesmav.com)
22 BRIDGES & MAVRAKAKIS LLP
23 3000 El Camino Real, 2nd Floor
24 Palo Alto, CA 94306
25 Telephone: (650) 804-7800
26 Facsimile: (650) 852-9224

27 Matthew D. Powers
28 (Matthew.Powers@tensegritylawgroup.com)
Steven Cherensky
(Steven.Cherensky@tensegritylawgroup.com)
TENSEGRITY LAW GROUP LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
Telephone: (650) 802-6000
Facsimile: (650) 802-6001

Attorneys for Apple Inc.

PROOF OF SERVICE

I am a citizen of the United States, more than 18 years old, and not a party to this action. My place of employment and business address is 201 Redwood Shores Parkway, Redwood Shores, California 94065. On January 28, 2013, I caused a copy of:

**NOTICE OF MOTION, MOTION TO COMPEL COMPLIANCE WITH SUBPOENA
DECLARATION OF ROBERT T. VLASIS IN SUPPORT APPLE'S MOTION TO
COMPEL COMPLIANCE WITH A SUBPOENA**

to be served as follows:

[XX] BY ELECTRONIC SERVICE I am readily familiar with the business practice at my place of business for electronically mailing a true and correct copy through Weil, Gotshal & Manges, LLP's electronic mail system to the e-mail address(es) set forth below, or as stated on the attached service list per agreement in accordance with Code of Civil Procedure section 1010.6.

Edward M. Mullins
emullins@astidavis.com
ASTIGARRAGA DAVIS MULLINS & GROSSMAN,
P.A.
701 Brickell Avenue, 16th Floor
Miami, FL 33131

Raymond N. Nimrod
raynimrod@quinnemanuel.com
Edward J. DeFranco
eddefranco@quinnemanuel.com
QUINN EMANUEL URQUHART & SULLIVAN,
LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010

Matthew Warren
matthewwarren@quinnemanuel.com
Charles K. Verhoeven
charlesverhoeven@quinnemanuel.com
David A. Perlson
davidperlson@quinnemanuel.com
QUINN EMANUEL URQUHART & SULLIVAN,
LLP
50 California Street, 22nd Floor
San Francisco, CA 93111

David A. Nelson
davenelson@quinnemanuel.com
QUINN EMANUEL URQUHART & SULLIVAN,
LLP
500 West Madison Street, Suite 2450
Chicago, IL 60661
(312) 705-7400

Executed on January 28, 2013 at Redwood Shores, California. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.


Plato Mok